



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,269	04/09/2001	Albert J. Sturm JR.	P19.12-0036	8135

27367 7590 10/09/2007
WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3319

EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
----------	--------------

3726

MAIL DATE	DELIVERY MODE
-----------	---------------

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/829,269

Applicant(s)

STURM ET AL.

Examiner

Essama Omgba

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 and 53-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-21 and 53-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 70 is objected to because of the following informalities: in line 1, "claim 58" should be inserted after "structure" based on Applicant's statement in the Remarks section, filed July 10, 2007, that claim 70 depends from claim 58. Consequently, claim 70 has been examined as depending from claim 58. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 53-63 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 53 recites limitations already recited in claim 12. Applicant argues that claim 53 recites that this claim recites that the housing is U-shaped. However that limitation is part of claim 54 and not claim 53.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-21 and 53-70 are rejected under 35 U.S.C. 102(b) as being anticipated by the sale of the claimed device on or about June 1998 as disclosed in the Information Disclosure Statement filed 10-26-2006.

Regarding the recitation of a "viscoelastic damping material" in claims 16, 17, 67 and 68 that the examiner interprets to be the "passive damper", although Applicant argues that the use of the "passive damper" was experimental, it is noted that the question posed by the experimental use doctrine is "whether the primary purpose of the inventor at the time of the sale, as determined from an objective evaluation of the facts surrounding the transaction, was to conduct experimentation." *Allen Eng 'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1354, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002), quoting *EZ Dock v. Schafer Sys., Inc.*, 276 F.3d 1347, 1356-57, 61 USPQ2d 1289, 1295-96 (Fed. Cir. 2002) (Linn, J., concurring). Experimentation must be the primary purpose and any commercial exploitation must be incidental. **

If the use or sale was experimental, there is no bar under 35 U.S.C. 102(b). "A use or sale is experimental for purposes of section 102(b) if it represents a bona fide effort to perfect the invention or to ascertain whether it will answer its intended purpose....If any commercial exploitation does occur, it must be merely incidental to the primary purpose of the experimentation to perfect the invention." *LaBounty Mfg. v. United States Int 'l Trade Comm 'n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992) (quoting *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1581, 222 USPQ 833, 838 (Fed. Cir. 1984)). **"The experimental use exception...does not include market testing where the inventor is attempting to gauge consumer demand for his**

Art Unit: 3726

claimed invention. The purpose of such activities is commercial exploitation and not experimentation." *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). See MPEP § 2133.03 (e). The examiner submits that Applicant has not provided enough evidence that experimentation was the primary purpose for including a passive damper in the device sold on or about June 1998.

Therefore, the claims are considered anticipated by the sale of the device on June 1998.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-21 and 53-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Helms (US Patent 5,042,162).

Applicant, at pages 1 and 2 of the specification discloses a gantry as substantially claimed except for the use of a viscoelastic damping material disposed in between overlapping segments of the housing. However Helms teaches a gantry including vibration damping material in the rails, bridge and table, the vibration material disposed between two plates, the vibration dampers being provided in any number or desired shape so as to provide maximum energy absorbency at major modes of

Art Unit: 3726

vibration, in the gantry, see column 3, lines 31-47, column 4, lines 3-18, column 10, lines 59-68 and the abstract. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have included viscoelastic vibration damping material in the device of AAPA, in light of the teachings of Helms, in order to provide maximum energy absorbency at major modes of vibration of the device.

Response to Arguments

8. Applicant's arguments with respect to claims 12-21 and 53-69 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

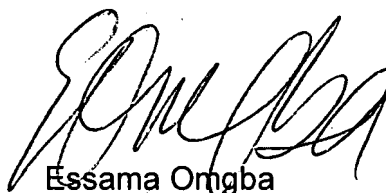
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Essama Ongba
Primary Examiner
Art Unit 3726

eo

October 1, 2007